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Docket No. 4126-4012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Rinehart et al.

Group Art Unit: 1614

Serial No.: 10/693,174

Examiner: Cook, Rebecca

Filed: October 23, 2003

For: COMPOSITIONS AND METHODS COMPRISING LONG-CHAIN, STRAIGHT-CHAIN 2-AMINO-3-HYDROXYALKANES

REQUEST TO RECONSIDER THE
PETITION FOR PRIORITY CLAIM UNDER 37 C.F.R. § 1.78(a)(6)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

To the Petitions Office:

In response to the *Decision on Petition Under 37 CFR 1.78(a)(6)* dated February 9, 2006, Applicants hereby request reconsideration of the dismissal of the petition.

The facts of the request for priority claim are set forth in the original petition dated November 18, 2005. The petition was dismissed on February 9, 2006 on the basis that it failed to comply with the requirement that it be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;

The *Decision on Petition Under 37 CFR 1.78(a)(6)* indicates that before the petition under 37 CFR 1.78(a)(6) can be granted, a substitute amendment deleting the incorporation by reference of the priority provisional applications and providing the filing date for provisional application 60/043,599 is required (see page 2, lines 15-17 of the *Decision on Petition Under 37 CFR 1.78(a)(6)*).

Applicants thank Frances Hicks of the Petitions Branch and Joni Chang of the Office of Patent Legal Administration for the courtesy of telephone interviews with respect to incorporation by reference, and for their helpful suggestions leading to the amendment submitted herewith.

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Docket No. 4126-4012
 Serial No. 10/693,174

Applicants file concurrently with this paper an amendment to the specification adding the filing date of provisional application 60/043,599, and amending the phrase "the disclosure of which is hereby incorporated herein by reference" which was present in the specification as filed to clarify that the incorporation by reference refers to application serial numbers 09/058,456, 60/043,326, and 60/043,599. Applicants note that the first paragraph of the specification of the present application as originally filed was as follows:

This application is a continuation-in-part of copending application Serial No. 09/058,456, filed April 10, 1998, the disclosure of which is hereby incorporated herein by reference.

Support for the incorporation by reference of application serial number 09/058,456 is found in the specification as originally filed. Therefore, the amendment clarifying the incorporation by reference of 09/058,456 is not new matter. In addition, Applicants note that the first paragraph of application serial number 09/058,456 incorporates by reference the provisional applications 60/043,326 and 60/043,599. Therefore, Applicants request reconsideration of the dismissal of the petition dated November 18, 2005.

The application received a *Notice of Allowance* on February 16, 2006.

Applicants believe that the *Petition for Priority Claim Under 37 C.F.R. § 1.78(a)(6)* submitted on November 18, 2005 entitles them to this request for consideration. However, in the event that an additional petition fee is required for this request for reconsideration, the Commissioner is hereby authorized to charge any fees which may be required by this paper to Deposit Account No. 13-4500, Order No. 4126-4012.

The Commissioner is hereby authorized to charge any fees which may be required by this paper, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4126-4012. A duplicate copy of this sheet is attached.

Respectfully submitted,
 MORGAN & FINNEGAN, L.L.P.

Dated: March 2, 2006

By:

Kenneth H. Sonnenfeld / Michael A. Willis
 Reg. No. 33,285 / Reg. No. 53,913



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